THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GRANT W. CHRISTIE
and
CAROL E. EBERHARDT

_____

Appeal No. 96-3204
Application 08/129,636[1]

_____

HEARD: February 3, 1998

_____

Before ABRAMS, FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

[1] Application for patent filed September 29, 1993.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 30 and 32 through 39, which are all of the claims remaining in this application. Claims 1 through 9 and 31 have been canceled.

Appellants' invention relates to a method of fixing a natural tissue heart valve and to a natural heart valve fixed in accordance with the recited method. On page 1 of the specification, it is explained that "fixation" is a procedure for stabilizing the tissue of the heart valve against degradation. A copy of representative claims 10, 27 and 32 may be found in Appendix A of appellants' brief.

There are no prior art references relied upon by the examiner in rejecting the appealed claims.

Claims 10 through 30 and 32 through 39 stand rejected only under 35 U.S.C. § 102(c) because the examiner considers that appellants had abandoned their invention and thus their right to patent the subject matter now claimed.

The examiner's explanation of the § 102(c) rejection and the response to appellants' arguments appears on pages 3 through 5 of the examiner's answer (Paper No. 13, mailed February 9, 1996). Appellants' arguments and viewpoints concerning the examiner's rejection of the appealed claims are found in the brief (Paper No. 12, filed November 6, 1995) and in the reply brief (Paper No. 15, filed March 19, 1996).

OPINION

In arriving at our decision in this appeal, we have carefully considered appellants' specification and claims, and the respective positions advanced by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of claims 10 through 30 and 32 through 39 under 35 U.S.C. § 102(c) will not be sustained. Our reasoning follows.

The facts giving rise to the rejection before us on appeal are set forth on pages 3 and 4 of appellants' brief. On page 2 of the examiner's answer, it is noted that the factual background presented by appellants "is not contested." We have carefully reviewed those facts and, essentially for the reasons

set forth in appellants' brief and reply brief, we find that appellants did not abandon their invention within the meaning of 35 U.S.C. § 102(c). While it is true that their first filed application, Ser. No. 07/752,130, went abandoned for failure to file a response to the final rejection therein, this does not constitute or in any way alone evidence an intent to abandon the invention on which that application was based. On the contrary, appellants (1) during the pendency of the first filed application, filed a PCT application (PCT/US92/06578) on the same invention disclosed in the '130 application, (2) upon realizing the error in allowing the first filed application to go abandoned, filed the present application on the invention, even though they had apparently lost their earlier filing date, and (3) also filed a petition to revive the first filed application --- all of which in our opinion weighs heavily against any inference that appellants had abandoned their invention and thereby sacrificed their right to obtain a patent on that subject matter. In our view, the record before us clearly establishes that applicants (Christie et al.) never lost interest in their invention. Like appellants, we are of the view that the examiner's reliance on the USM case (cited on page 3 of the answer) is misplaced, since unlike in that case, there is no

evidence in the case before us on appeal of an intent to abandon the invention.

In sum, after reviewing the facts and the cases cited, both pro and con, it is our opinion that the examiner has not shown, by clear and convincing evidence, that appellants abandoned their invention within the meaning of 35 U.S.C. § 102(c). Accordingly, the examiner's rejection of claims 10 through 30 and 32 through 39 is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

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